

REMARKS/ARGUMENTS

Applicant has studied the Office Action dated March 7, 2005, and has made amendments to the claims. It is submitted that the application, as amended, is in condition for allowance. By virtue of this amendment, claims 1-22 are pending. Claims 1-3, 7, 9, 11, 13, and 15 are amended. Reconsideration and allowance of the pending claims in view of the above amendments and the following remarks is respectfully requested.

In the Office Action, the Examiner:

- (page 2) objected to claim 15 for informalities;
- (page 2) acknowledged election of claims;
- (page 3) acknowledged receipt, on February 28, 2005, of applicant's corrected information disclosure statement;
- (pages 3-7) rejected claims 1-15 and 17-22 under 35 U.S.C. § 102(e) as being anticipated by Lee et al. (U.S. Patent No. 6,779,040); and
- (pages 7-8) rejected claims 16-18 under 35 U.S.C. § 103(a) as being unpatentable over Lee et al. (U.S. Patent No. 6,779,040) in view of Salo et al. (U.S. Patent No. 6,563,800).

(Page 2) Objection to Claim 15 for Informalities;

As noted above, the Examiner objected to claim 15 for informalities. Specifically, the Examiner objected to the word "the" in the "...image record, the at least..." in claim 15.

Applicant respectfully disagrees with the Examiner's objection. Amended claim 15 recites, *inter alia*:

... a first database for storing records containing image delivery parameters and image presentation parameters associated with the at least one networked device, and
a second database for storing **at least one image record, the at least one image record** containing...
(emphasis added)

The recitation of "the at least one image record" derives proper antecedent basis from

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the recitation of "at least one image record" immediately preceding the objected-to portion of claim 15. Because "the at least one image record" has proper antecedent basis, the word "the" is not a typo and the Examiner's objection to claim 15 should be withdrawn.

(Page 2) Acknowledged Election of Claims

The Applicants wish to thank Examiner Nguyen for acknowledgment of the restriction election. The Examiner requested that Applicant elect either Group I, which includes claims 1-22, or Group II, which includes claims 23-30. On February 28, 2005, an election of Group I, claims 1-22 was made by applicant's representative in a telephone conversation with Examiner Nguyen. Applicant hereby confirms election of Group I, claims 1-22 without prejudice or disclaimer, and withdraws Group II, claims 23-30, from the instant application. Applicant expressly reserves the right to file a divisional application with the non-elected claims.

Applicant also wishes to point out that the definitions of Groups I and II on page 2 of the Office action are correct and the definitions listed on page 3 of the Office action are incorrect and do not recited Applicant's elected claims within Group I.

(Pages 3-7) Rejection under 35 U.S.C. §102(e) Lee et al.

As noted above, the Examiner rejected claims 1-15 and 17-22 under 35 U.S.C. § 102(e) as being anticipated by Lee et al. (U.S. Patent No. 6,779,040).

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful. Amended independent claims 1-3 recite, *inter alia*:

...
determining, based on an automatically determined image delivery parameter an image presentation parameter associated with the networked device, **an image format** for the image information for delivery of the image information to the networked device and for presentation of the image information at the networked device...
(emphasis added)

Amended claims 7 and 9 recite, *inter alia*:

...
determining an image format for the displayable image information from an automatically determined image delivery parameter and an image presentation parameter associated with the networked client device. (emphasis added)

Amended claim 11 recites, *inter alia*:

...
selecting one of the available image formats, based at least in part on the automatically determined image delivery parameter and the image presentation parameter, for delivery to and presentation at the networked device. (emphasis added)

Amended claim 13 recites, *inter alia*:

...
determining, based on the automatically determined image delivery parameter and the image presentation parameter associated with the at least one networked device, an image format for the image information for delivery of the image information to the at least one networked device and for presentation of the image information at the at least one networked device

Lee et al. discloses a method and system for on-demand data compression of data files for transfer from a server computer to a client computer. Lee, col. 2, lines 62-63. A **user may register various user preferences and user computer capabilities** with the server computer prior to requesting the data file, or may indicate some or all of the preferences and capabilities at the time of the request for the data file. Lee, col. 2, line 64 through col. 3, line 1. Importantly, **the preferences and capabilities are known only after a user registers them**. "An example of an indicated parameter might, for example, be a parameter indicating the bandwidth of the client computer's interconnection with the Internet". Lee, col. 12, lines 59-62. The server computer then compresses the requested data file according to the capabilities of the user's computer and user preferences. Lee, col. 3, lines 1-4.

In other words, Lee et al. adjusts the size of data files sent to a client computer **based only on parameters of the client device and client preferences** that are sent to the Lee et al. system **by the client**.

In contrast to Lee et al., the presently claimed invention, as recited in the amended independent claims 1-3, 7, 9, 11, and 13, is able to automatically determine image delivery parameters and image presentation parameters. Therefore, the present invention, does not require user input to determine image delivery parameters and image presentation parameters, as taught by Lee.

The specification of the instant application recites:

[T]he Image Format Determination Server 248 would regularly receive updates to the capability database 258 via the network 202. According to one preferred embodiment, web content servers 208 would receive communications with networked devices 204, 206, and collect capability information corresponding to the networked devices 204, 206. For example, as the first networked device 204 accesses the network 202 from varying communication links, the **changes in communication capability can be monitored by the web content server's 208 and updated** to the capability database 258 in the Image Format Determination Server 248. The image server 214, for example, would send an update message to the image proxy engine 256. The image proxy engine 256 would then accordingly update the capability database 258. Similarly, if a new presentation resource (e.g. a new display system) is being used in the first networked device 204, for example, then the image server 214 would send an update to the image proxy engine 256 to update accordingly the capability record corresponding to the first networked device 204, as stored in the capability database 258. Page 27, line 15 through page 28, line 10.

Independent claims 1-3, 7, 9, 11, and 13, recite these features.

The Examiner cites 35 U.S.C. § 102(e) and a proper rejection requires that a single reference teach (i.e., identically describe) each and every element of the rejected claims as being anticipated by Lee et al.¹ Because the elements in independent claims

¹ See MPEP §2131 (Emphasis Added) "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim."

1-3, 7, 9, 11, and 13 of the instant application are not taught or disclosed by Lee et al., the apparatus of Lee et al. does not teach or anticipate the present invention as claimed. The dependent claims are believed to be patentable as well because they all are ultimately dependent on either claim 1, 2, 3, 7, 9, 11, or 13, respectively. Accordingly, the present invention distinguishes over Lee et al. for at least this reason. The Applicants respectfully submit that the Examiner's rejection under 35 U.S.C. § 102(e) has been overcome. The Examiner should withdraw the rejection of these claims.

(Pages 7-8) Rejection under 35 U.S.C. §103(a) Lee et al. in view of Salo et al.

As noted above, the Examiner rejected claims 16-18 under 35 U.S.C. § 103(a) as being unpatentable over Lee et al. (U.S. Patent No. 6,779,040) in view of Salo et al. (U.S. Patent No. 6,563,800).

The deficiencies of Lee et al. are discussed in the preceding section entitled "Rejection under 35 U.S.C. §102(e) Lee et al." Claims 16-18 depend from independent 13. Similar to Lee et al., Salo neither shows nor suggests **"determining, based on the automatically determined image delivery parameter and the image presentation parameter associated with the at least one networked device, an image format for the image information for delivery of the image information to the at least one networked device and for presentation of the image information at the at least one networked device"** as recited in claim 13 of the instant application.

It is accordingly believed to be clear that Lee et al., whether taken alone or in any combination with Salo et al. neither shows nor suggests the features of independent claim 13. Claim 13 is, therefore, believed to be patentable over the art. Dependent claims 16-18 are believed to be patentable as well because they all are dependent from claim 13.

Continuing further, when there is no suggestion or teaching in the prior art for **"determining, based on the automatically determined image delivery parameter**

and the image presentation parameter associated with the at least one networked device, an image format for the image information for delivery of the image information to the at least one networked device and for presentation of the image information at the at least one networked device" the suggestion can not come from the Applicant's own specification. The Federal Circuit has repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP § 2143 and Grain Processing Corp. v. American Maize-Products, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and In re Fitch, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The prior art reference Lee et al. taken alone and/or in view of Salo et al. does not teach or suggest "determining, based on the automatically determined image delivery parameter...an image format". Accordingly, claims 16-18 distinguish over Lee et al. taken alone and/or in view of Salo et al. for this reason as well.

Accordingly, in view of the amendments and remarks above, since neither Lee et al., Salo et al., nor any combination of the two cited references, teaches, anticipates, or suggests, the presently claimed "determining, based on the image delivery parameter and the image presentation parameter," Applicants believe that the rejection of Claims 16-18 under 35 U.S.C. 103(a) has been overcome. The Examiner should withdraw the rejection of these claims.

CONCLUSION

The foregoing is submitted as full and complete response to the Official Action mailed March 7, 2005, and it is submitted that Claims 1-22 are in condition for allowance. Reconsideration of the rejection is requested. Allowance of Claims 1-22 is earnestly solicited.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless Applicants have argued herein that such amendment was made to distinguish over a particular reference or combination of references.

Applicants acknowledge the continuing duty of candor and good faith to disclose information known to be material to the examination of this application. In accordance with 37 CFR § 1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment are limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicants and the attorneys.

If the Examiner believes that there are any informalities that can be corrected by Examiner's amendment, or that in any way it would help expedite the prosecution of the patent application, a telephone call to the undersigned at (561) 989-9811 is respectfully solicited.

The Commissioner is hereby authorized to charge any fees that may be required or credit any overpayment to Deposit Account **50-1556**.

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In view of the preceding discussion, it is submitted that the claims are in condition for allowance. Reconsideration and re-examination is requested.

Respectfully submitted,

Date: June 7, 2005

By:

A handwritten signature in black ink, appearing to read "Jose Gutman", written over a horizontal line.

Jose Gutman

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